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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,850	12/14/2000	Jose Raul San Miguel Gomez	JG-GV-4999 /5	8133

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NEW YORK, NY 10022-7650

EXAMINER

ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 09/02/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/622,850

Applicant(s)

SAN MIGUEL GOMEZ ET AL.

Examiner

Mitra Aryanpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 24 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the U.S.A. on 12/14/2000. It is noted, however, that the file does not contain such a copy nor has applicant filed a certified copy of the Spanish application as required by 35 U.S.C. 119(b).

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 8 (see figure 4; also the Abstract of the Disclosure).

### ***Specification***

3. 37 CFR 1.52(b) requires that the pages of the specification including claims and abstract, be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text. The lines of the specification, and any amendments to the specification, must be 1 ½ or double-spaced. Appropriate correction is required for the above objections.

### ***Claim Objections***

4. Claims 2, 5 and 6 are objected to because of the following informalities: In claim 2, line 3, "respecting" should be changed to --representing--; in claims 5 and 6 "football" should be changed to "soccer". Additionally, the reference numerals used in the claims, to define the various parts and features of the invention have not been corrected to conform to the specification and drawings. Appropriate correction is required for the above objection.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the said sport" in line 3; "the practice" in line 3; "the ankle" in line 10; "the player" in line 8. There is insufficient antecedent basis for these limitations in the claim.

Claim 2 recites the limitation "the base" in line 2. There is insufficient antecedent basis for this limitation in the claim. Additionally, an alternative way of defining the base is to say "the base of the body".

7. Claims 3 and 4 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. Therefore, "according to the above claims" should be changed to read "according to claim #". See MPEP § 608.01(n). Note: in the preliminary Amendment dated August 28, 2000 the dependency of claims 3 and 4 were changed. Therefore, it is unclear what the dependency of these claims are, since no instructions were included as to this change?

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Sanderne (FR 719,778).

Regarding claim 1, Sanderne discloses an apparatus characterized by the fact that it is composed of a body (1) that reproduces the shape and size of a human foot fairly faithfully, up to the top of the foot (see figures 1-5), while from the top of the body (1) a short arm (15 or in the alternative 14) emerges, this ending in a handle (centralized section 16) arranged noticeably parallel to the axis of the body (1), in such a way that a person can handle and manipulate the apparatus with the movement of the wrist. Note that, in accord with the Court's instructions in Kropa v. Robie 187 F.2d 150, 88 USPQ 478, and other decisions, no weight is being given to the statements of intended use in the preamble.

Regarding claim 2, Sanderne shows the base (not identified by a reference number, but clearly seen in all the figures) of body (1) is symmetrically representing an imaginary longitudinal, vertical and middle plane, while both sides are concavely curved (best see in figure 2).

Regarding claim 3, Sanderne shows the structure to be composed of a multiplicity of parts conveniently assembled together.

Regarding claim 5, see the comments for claim 3.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanderne (FR 719,778) in view of Cumbie (5,040,813).

Regarding claims 4 and 6, Sanderne does not provide a support for the apparatus. There is nothing new or unobvious about providing a support or holder for an object, in the instant case the apparatus of Sanderne. Nevertheless for the sake of argument, Cumbie shows an accessory holder and mount for wheelchairs (see figures 5-12, column 3, lines 61-68 and column 4, lines 1-62). Cumbie's accessory holder can be any shape and size and it is suitable for affixing to any suitable point on a wheelchair (see figures 5-11), the accessory holder allows for a variety of different objects to be temporarily held in place in order to allow the upper limbs to be free during the movement of the wheelchair (see figure 1). Absent a showing of new or unobvious results, it would have been obvious to have utilized the accessory holder of Cumbie shown in figure 8, for holding and/or carrying a plurality of different objects, in the instant case the apparatus of Sanderne in order to aid a wheelchair-bound person to handle the wheelchair more easily.

**Note:** The structural limitation of the device as claimed, is old and well known. However, the specific method of use in conjunction with the specific structure of the claimed device may distinguish patentably over the art of record in this application.

#### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

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In response to applicant's argument with respect to the intended use, a recitation of the intended use of the claimed invention, in the instant case playing soccer in a wheelchair must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). In response to applicant's arguments, the recitation for playing soccer in a wheelchair, having the aim of allowing disabled individuals with partial or total immobility of the legs to use their upper limbs to replace these for the practice of the said sport has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

With respect to applicant's remarks that the Thompson reference does not faithfully show a reproduced shape and size of a human foot. The Thompson reference shows a boot/shoe tree that is used to be placed in a shoe or boot of a human. Therefore, it inherently conforms to the shape of a human foot. Nevertheless for the sake of argument the Sanderne (FR 719,778) reference has been applied which faithfully shows the reproduced shape and size of a human foot.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T Sewell can be reached on 703-308-2126. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

MA  
28 August 2003

  
Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700